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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/986,005	11/07/2001	Naoto Ikegawa	215900US0	4580

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OBLON, SPIVAK, MCCLELLAND, MAIER & NEUSTADT, P.C.
1940 DUKE STREET
ALEXANDRIA, VA 22314

EXAMINER

KRUER, KEVIN R

ART UNIT	PAPER NUMBER
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1773

DATE MAILED: 02/20/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Advisory Action

Application No.

09/986,005

Applicant(s)

IKEGAWA ET AL. 

Examiner

Kevin R Kruer

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--The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

THE REPLY FILED 15 January 2004 FAILS TO PLACE THIS APPLICATION IN CONDITION FOR ALLOWANCE. Therefore, further action by the applicant is required to avoid abandonment of this application. A proper reply to a final rejection under 37 CFR 1.113 may only be either: (1) a timely filed amendment which places the application in condition for allowance; (2) a timely filed Notice of Appeal (with appeal fee); or (3) a timely filed Request for Continued Examination (RCE) in compliance with 37 CFR 1.114.

PERIOD FOR REPLY [check either a) or b)]

- a) ☐ The period for reply expires _____ months from the mailing date of the final rejection.
- b) ☐ The period for reply expires on: (1) the mailing date of this Advisory Action, or (2) the date set forth in the final rejection, whichever is later. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of the final rejection.

ONLY CHECK THIS BOX WHEN THE FIRST REPLY WAS FILED WITHIN TWO MONTHS OF THE FINAL REJECTION. See MPEP 706.07(f).

Extensions of time may be obtained under 37 CFR 1.136(a). The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The appropriate extension fee under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the shortened statutory period for reply originally set in the final Office action; or (2) as set forth in (b) above, if checked. Any reply received by the Office later than three months after the mailing date of the final rejection, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

1. ☒ A Notice of Appeal was filed on 15 January 2004. Appellant's Brief must be filed within the period set forth in 37 CFR 1.192(a), or any extension thereof (37 CFR 1.191(d)), to avoid dismissal of the appeal.
2. ☒ The proposed amendment(s) will not be entered because:
- (a) ☒ they raise new issues that would require further consideration and/or search (see NOTE below);
 - (b) ☐ they raise the issue of new matter (see Note below);
 - (c) ☒ they are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal; and/or
 - (d) ☐ they present additional claims without canceling a corresponding number of finally rejected claims.

NOTE: _____

3. ☐ Applicant's reply has overcome the following rejection(s): _____.
4. ☐ Newly proposed or amended claim(s) _____ would be allowable if submitted in a separate, timely filed amendment canceling the non-allowable claim(s).
5. ☒ The a) ☐ affidavit, b) ☐ exhibit, or c) ☒ request for reconsideration has been considered but does NOT place the application in condition for allowance because: see attached.
6. ☐ The affidavit or exhibit will NOT be considered because it is not directed SOLELY to issues which were newly raised by the Examiner in the final rejection.
7. ☒ For purposes of Appeal, the proposed amendment(s) a) ☒ will not be entered or b) ☐ will be entered and an explanation of how the new or amended claims would be rejected is provided below or appended.

The status of the claim(s) is (or will be) as follows:

Claim(s) allowed: NONE.

Claim(s) objected to: NONE.

Claim(s) rejected: 1 and 3-16.

Claim(s) withdrawn from consideration: NONE.

8. ☐ The drawing correction filed on _____ is a) ☐ approved or b) ☐ disapproved by the Examiner.
9. ☐ Note the attached Information Disclosure Statement(s) (PTO-1449) Paper No(s). _____.
10. ☐ Other: _____

Advisory Action

Applicant's arguments filed January 15, 2004 have been fully considered but are not persuasive. Applicant's proposed amendments will not be entered because they would require further search and/or consideration, and are deemed not to place the application in better form for appeal by materially reducing or simplifying the issues on appeal. Specifically, the amendments would require the examiner to determine whether the showing made in the specification was unexpected and agreed in scope with the claims.

Applicant argues that the proposed amendment would overcome the following rejections:

Claims 1, 3, 5, 11 and 14 under 35 U.S.C. 102(b) as anticipated by U.S. 5,019,442

(Ogawa et al); and under 35 U.S.C. 103(a) of:

Claims 1, 11 and 14 over U.S. 4,772,496 (Maeda et al) in view of Applicants'

Admissions (AA);

Claims 1, 3, 5, 11, and 13 over AA in view of U.S. 6,124,004 (Furuta et al);

Claims 6-10 and 12 over AA in view of Furuta et al, and further in view of U.S.

4,943,606 (Inoue et al);

Claims 1, 11 and 16 over U.S. 4,337,279 (Polak) in view of U.S. 4,654,255 (Koiima et al); and

Claims 1, 3, 11 and 15 over Polak in view of U.S. 5,418,286 (Takahashi et al), are all respectfully traversed.

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Applicant's arguments with respect to these rejections are moot since the proposed amendment has not been entered.

With respect to Polack in view of Orikasa, Applicant argues that there is no motivation for one skilled in the art to choose the composition taught in Orikasa as the polymer component of Polak out of thousands, if not more, of known polymer compositions. The examiner respectfully disagrees. Polak teaches that the polymer component should be selected from a Markush group comprising polyamide. Orikasa teaches that a specific polyamide composition comprising terephthalamide or isophthalamide (col 3, lines 50+) and an ethylene-glycidyl methacrylate-ethyl acrylate copolymer (col 4, lines 64+) has superior mechanical toughness, durability, solvent resistance, moldability, and impact resistance (col 1, lines 7+). Thus, the examiner maintains the position that it would have been obvious to one of ordinary skill in the art to select the composition taught in Orikasa as the polymer component of Polak for the purpose of increasing the mechanical toughness, durability, solvent resistance, moldability, and impact resistance of the metal clad polymer component.

Applicant further argues that Orikasa discloses and suggests nothing with regard to depositing a metal on their thermoplastic resin composition. The examiner agrees with applicant's reading of Orikasa, but points out that Orikasa was never relied upon for such a teaching. Rather, Polak was relied upon to teach a metal clad polymer component.

According to Applicant, the inclusion of rubber-like elastic material in the base resin comprised of a thermoplastic resin or a thermosetting resin unexpectedly improves

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metal adhesion to said resin. In support of said position, Applicant has pointed to the examples in the specification. However, the showing in the specification does not agree in scope with the claims. Specifically, only two species of base resins are utilized in the examples. One of ordinary skill in the art would not be able to conclude that the results observed for the two species of base resins utilized could be reasonably expected for all thermoplastic and thermosetting resins. The examiner further notes that Example 4 (utilizing rubber D) has approximately the identical peel strength as comparative example 1, and that only one species of rubber-like material has been utilized with PPS. Furthermore, the examiner notes that pending claims 1, 3, 5, 11, and 14 are rejected under 35 U.S.C. 102(b) as being anticipated by Ogawa. A showing of unexpected results is not sufficient for overcoming a rejection based upon 35 U.S.C. 102.

With regard to the term "plate-form" in claims 7 and 8, the examiner notes that there is no outstanding 35 U.S.C. 112, second paragraph rejection. The term "plate-form" is understood in the specification to include any particle with an aspect ratio of not equal to 1.

In addition to the art arguments addressed above, Applicant also traverses the finality of the Office action since all the new rejections were not necessitated by Applicant's amendments. Specifically, Applicant argues that the rejection of amended claim 1, which is identical to original claim 2, for the first time under Ogawa and Polak combined with other newly cited prior art makes the finality improper. The examiner respectfully disagrees. By amending claim 1, Applicant amended the scope of every claim depending directly or indirectly therefrom, claims 1-11. Applicant also added

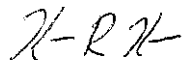
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additional claims 12-16. In order to address the limitations of claims 12-16 and the narrower scope of claims 1-11, new rejections based upon Ogawa and "Polak combined with other newly-cited prior art" were necessitated. Since the dependent claims necessitated newly cited art to be applied and any rejection of a dependent claim requires that the claim from which it depends also be rejected (since the dependent claim further limits the claim from which it depends), the rejection of claim 1 under new grounds was necessitated by Applicant's amendments.


Any inquiry concerning this communication or earlier communications from the examiner should be directed to Kevin R Kruer whose telephone number is 703-305-0025. The examiner can normally be reached on Monday-Friday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Paul Thibodeau can be reached on 571-272-1516. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Kevin R. Kruer
Patent Examiner-Art Unit 1773



Paul Thibodeau
Supervisor
Art Unit 1773